

REMARKS/ARGUMENTS

Claims 58-113 are pending in the present application. Claims 58-113 stand rejected. Reconsideration of the present application is respectfully requested in view of the following remarks.

Applicants appreciate the withdrawal of the rejections made in the previous Office Action.

In the Office Action dated May 4, 2005, there is a single rejection of all of the pending claims (58-113) under 35 U.S.C. §103(a). Specifically, claims 58-113 have been rejected under §103(a) as being unpatentable over Kirk (US 4,966,779) in view of each of Parfitt (Martindale, 32nd ed., pp. 1358-1359, 1366-1370), Winstrom et al. (US 3,708,583) and Pomp (US 5,935,918). This rejection is respectfully traversed for the reasons set forth below.

Initially, although the rejection is stated to be over Kirk (the primary reference) in view of each of the secondary references, the reasoning given for the rejection shows that the Examiner is actually combining the primary reference with at least two other references to allegedly obtain the invention that is claimed in claims 58-113. It is respectfully submitted that the fact that the Examiner cannot find all of the claimed elements of even the broadest claims of the present application in a combination of two references is evidence that the claimed invention is non-obvious, especially when one of the more important references is from a completely unrelated scientific field.

As the Examiner has acknowledged, the Kirk patent contains no teaching whatsoever concerning the use of an alkyl lactate in the vitamin-containing emulsions described therein. Further, the Kirk patent contains no teaching which would lead one of ordinary skill in the art to believe that an alkyl lactate could be safely added to the emulsion of the Kirk patent while still maintaining the desired properties and characteristics of the Kirk emulsion. If anything, the Kirk patent teaches away from making any changes to the composition of the emulsions described therein. For example, in the abstract of the Kirk patent it is stated that the emulsions contain

“specific proportions” of the listed ingredients. The importance of not varying the composition of the emulsion is emphasized at column 6, lines 37-53, where emulsions that used all of the listed ingredients in the ranges specified in the patent were compared to: (1) emulsions missing one or more of those ingredients; and (2) emulsions that contained all of the listed ingredients but wherein one or more of the listed ingredients was not present in an amount that was within the specified range for that ingredient. As discussed at column 6, lines 48–53, and shown in Table 1, even slight variations in the composition of the emulsions led to the loss of the desirable properties and the exhibition of certain undesirable characteristics. Accordingly, there is no teaching in the Kirk patent that would motivate an artisan of ordinary skill to modify the composition of the emulsions described therein and, even if an artisan somehow found the requisite motivation to modify the composition of the emulsions, that artisan would not have an expectation of success because the Kirk patent teaches that even minor modifications to the composition of the emulsions leads to a loss of their desired properties and the exhibition of certain undesirable characteristics.

The Examiner has apparently realized that the Kirk patent does not contain any teachings that would motivate one of ordinary skill to add an alkyl lactate to the emulsions described therein. In an attempt to overcome this problem, the Examiner has cited the Winstrom et al. patent to show that in the vitamin composition described therein, flavoring additives are a possible addition to the composition. However, there is no teaching in the Winstrom et al. patent about the identity or the amount of the flavoring agent that would be acceptable. Thus, even assuming arguendo that the teachings of the Winstrom et al. patent could be properly combined with the teachings of the Kirk patent, there would still be no teaching that an alkyl lactate could be added to the composition of the Kirk patent as a flavoring agent and no teaching about how much alkyl lactate would be suitable as a flavoring agent in an emulsion of the type described in the Kirk patent.

In an attempt to overcome the shortcomings of the combined teachings of Kirk and Winstrom et al., the Examiner has cited the Pomp patent, arguing that the Pomp patent teaches that butyl lactate is an FDA approved flavor additive. However, the Examiner makes no mention

of the fact that the Pomp patent does not contain any disclosure that butyl lactate would be suitable for use in vitamin compositions. Further, the Examiner makes no mention of the fact that the Pomp patent is directed to the use of butyl lactate (and/or amyl lactate) as a solvent for detaching fouling residue from the bore of a firearm. The teaching of the Pomp patent as a whole is directed to a completely different and unrelated field of use for butyl lactate. There is no question that this patent would not be considered (i.e., by a person of skill in this art) as being part of the teachings of the pertinent or relevant art to the invention of the present application or the inventions described in Kirk and Winstrom et al. As such, it is not proper to combine the teachings of this patent with the teachings of Kirk or Winstrom et al.

In addition to the arguments made above, it is respectfully submitted that the Pomp patent does not provide any teaching of how much butyl lactate to use in a liquid vitamin emulsion or composition. The only teaching of the amount of butyl lactate to use in the Pomp patent is solutions that contain about 75% by weight butyl lactate (to be used as firearm cleaning solutions). Thus, even assuming arguendo that the teachings of the Pomp patent could be somehow combined with the teachings of Winstrom et al. and Kirk, there is still no teaching of how much butyl lactate to use in such vitamin formulations.

Finally, in addition to all of the other arguments made above, it is respectfully submitted that the Kirk patent teaches away from the addition of any flavoring agents to the emulsions of that patent. Specifically, among the many objects of the invention described in the Kirk patent, one of the objects is to form an emulsion that has “a low flavor and odor profile” (see paragraph bridging columns 1 and 2). Thus, an artisan of ordinary skill would not be motivated to add a flavoring agent to the emulsions of the Kirk patent, since this would be counter to one of the objects of the invention of the Kirk patent.

In view of all of the above, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness.

It is also worth noting that the additive compositions of the present invention do not use the alkyl lactates as a flavoring additive. Instead, the alkyl lactates act as solvents to lower the

viscosity of the vitamin oils to a level that allows practical handling while, at the same time, keeping the flashpoint of the additive composition at about 200°F or greater.

It is respectfully submitted that the remaining arguments made by the Examiner are not relevant if the teachings of the Pomp patent cannot be combined with the teachings of the other references or if the teachings of the Pomp patent are deficient (e.g., since they do not teach the amount of butyl lactate to use in vitamin compositions and only teach very high percentages of butyl lactate for use in firearm cleaning solutions). Accordingly, even though applicants do not agree with the aforementioned remaining arguments, it is respectfully submitted that there is no need to address them here (except for the argument concerning the concentrations of the various components, which is briefly discussed below).

An argument was made in the Office Action that it would have been obvious to prepare a composition with the concentrations as instantly claimed because the claimed concentrations overlap with those taught by the combined references. This statement is not correct. Even assuming arguendo that the references could be combined in the manner proposed by the Examiner (which applicants submit would be improper), none of these references provide any teaching of an amount of the alkyl lactate that would overlap with the amounts recited in the present claims. For example, the Winstrom et al. patent does not provide any teaching of the amount of "flavoring agents" that should be used. The only teaching in the Pomp patent concerning the amount of butyl or amyl lactate to be used relates to their use as solvents in firearm cleaning solutions, where the lactates are the major component (usually about 75% by weight). Accordingly, there is no teaching of an amount of alkyl lactate that would overlap with the ranges recited in the present claims.

Reconsideration of the present application and a favorable action concerning claims 58-113 is respectfully requested.

Respectfully submitted,
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